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|----------------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| APPLICATION NO.                                                                                                | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/539,192                                                                                                     | 06/16/2005  | Gordon Feingold      | 09138.0074          | 2551             |
| 63432 7590 02/10/2009<br>DAKO/FINNEGAN, HENDERSON, LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      | EXAMINER            |                  |
|                                                                                                                |             |                      | GORDON, BRIAN R     |                  |
| ART UNIT                                                                                                       |             | PAPER NUMBER         |                     |                  |
| 1797                                                                                                           |             |                      |                     |                  |
| MAIL DATE                                                                                                      |             | DELIVERY MODE        |                     |                  |
| 02/10/2009                                                                                                     |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                    |                     |
|------------------------------|------------------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b>             | <b>Applicant(s)</b> |
|                              | 10/539,192                         | FEINGOLD ET AL.     |
|                              | <b>Examiner</b><br>Brian R. Gordon | Art Unit<br>1797    |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on **6-16-05**.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) **318-338** is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) **318-330** is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08e)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

##### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 318-319, 334 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is meant by establishing a network connection. Is this simply physically connecting the stainer to a cable or does this include programming the stainer as well?

Furthermore it is unclear how or what is used to send and receive responses. Does an operator send and receive the responses or are the responses automatically sent and received? Is a computer or some other electrical device connected to the stainer and used for sending and receiving?

As to claim 319, there is no antecedent basis for "the plurality of stainers".

As to claim 334, there is no antecedent basis for "the operator".

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 318-338 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim asserts the method is for performing operations. There are no operations claimed. Sending commands and receiving responses over a network do not define an operation. It is unclear how one would perform an operation as claimed.

It should be noted claims 319-320, 322-325, 328-335, and 337-339 do not add any further steps for performing the method. There are no positively claimed steps for performing any further actions of the method. The claims are directed to what the method "may be" used for. The term "may be" implies option not a requirement. For example, see claims 324-325, 335.

Claims 330-337 appear to be directed to "the operations", but there are no specific steps given to enable one to perform "diagnostic tests". As claimed the teachings of sending and receiving information over a network is equivalent to performing operations.

Claims 331-332 are directed to instead or desired use of diagnostic tests rather than limiting the method of the instant claims.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 318-338 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemme et al. US 2002/011049 A1.

Lemme et al. disclose a method and apparatus for an automated biological reaction system. In the processing of a biological reaction system, there is a need for consistently placing an amount of fluid on a slide. In order to operate the automated biological reaction system more reliably, the system is designed in modular pieces with higher functions performed by a host device and the execution of the staining operations performed by remote devices. Also, to reliably catalog data which is used by the automated biological reaction system, data is loaded to a memory device, which in turn is used by the operator to update the operator's databases. The generation of the sequence of steps for the automated biological reaction device based on data loaded by the operator, including checks to determine the ability to complete the run. (Abstract).

FIG. 5A, shows a block diagram of the automated biological reaction system 150. The automated biological reaction system 150 is segmented into a host device 32 (server), which includes a typical personal computer, and at least one remote device 166, which includes the automated biological reaction device in FIGS. 2 and 6A. In the preferred embodiment, there are up to eight remote devices 166 which communicate with the host device 32. Each remote device 166 on the network has a unique address so that each remote device 166 may be identified and individually controlled by the host device 32. As described subsequently in FIG. 5B, the automated biological reaction system 150 can support up to eight remote devices 166 due to the 3 bits (values 0-7) dedicated to the addressing of the remote devices 166. A rotary switch is provided on

the remote device 166 to allow for the identification and the changing of the 3 bit address for each remote device 166. All host messages include this address in them, as described subsequently in FIG. 5B. However, the number of remote devices 166 can be smaller or larger than eight, depending on the capacity requirements or practical limitations of the laboratory in terms of space. Moreover, the remote devices 166 may be immunohistochemistry staining modules, another type of instrument that performs a different type of staining, or another type of medical testing device. (paragraph 105).

Communication between the host device 32 and the remote devices 166 is accomplished using a serial RS-485 link, which serves as a network, that supports one host and up to 32 remotes at one time. In the preferred embodiment, addressing of the remote devices 166 allows up to 8 remote devices to communicate with the host at one time. The RS-485 link has at least two pairs of lines for communication, one pair for transmitting and one pair for receiving. The remote devices 166 which are connected to the network "hear" the host messages but do not "hear" other remote messages. In the preferred embodiment, all communications begin with a host message, followed a short time later by a response by a remote device 166 if present. (sending/receiving) If the host device 32 sends a message and there is no remote device 166 to respond to it, the host device 32 times out. In this manner, the communication provides a simple, collision-free link between the host device 32 and the remote devices 166. In an alternative embodiment, the remote devices 166, in addition to communicating with the host device 32, address each other. For example, the remote devices 166 address each

other using the unique 3 bit address, sending information about staining runs, which are described subsequently. (paragraph 106).

The user database, which is required by the regulations, contains various tables including the registration, receive and quality control tables for use by the operator. Within each of the registration, receive and quality control tables, there are five different types of categories: (1) antibodies; (2) reagents; (3) kits; (4) consumables, and (5) control slides. (paragraph 226).

The claims not appear to claim in novel aspects of the use of computer networks. Computer networks are staple components of today's society. It is readily known that WAN and LAN networks are employed for sending various types of data (including encrypted, i.e. internet or intranets) in various environments ranging from private homes, businesses, hospitals (see paragraph 240), laboratories, etc. The use of networking and backup hardware/software is inherent in a network configuration such as that taught by Lemme et al. (see also Showalter, provisional application 60/487,998, prior art submitted by applicant).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kram; Brian H. et al.; Nakaya; Masanori et al.; Ford; Anthony et al.; Lefebvre; Gilles et al.; Fauzzi; John A. et al.; Key; Marc E. et al.; Winther; Lars; Nishikiori; Mizuho et al.; Higuchi, Hideyuki; Tseung, Ken K. et al.; Lemme, Charles D. et al.; Hirai, Yoshikazu et al.; Richards, William et al.; Pressman, Norman J. et al.;

Feingold; Gordon et al.; Mayer; William J.; and Tseung; Ken K. et al. disclose slide  
stainers configured in networks.

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Brian R. Gordon whose telephone number is 571-272-  
1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for  
the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the  
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USPTO Customer Service Representative or access to the automated information  
system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/  
Primary Examiner  
Art Unit 1797